

REMARKS

The claims in the application are 14-32 and Claim 41-49 added by the present Amendment.

Favorable reconsideration of the application as amended is respectfully requested.

Claims 36-40 which have been withdrawn from consideration in paragraph 4 of the Office Action have been canceled without prejudice, the right specifically being reserved to pursuing a divisional application to the subject matter of these withdrawn claims. The specification of the present application has been amended to include material from copending U.S. appln. Ser. No. 09/211,310 filed Dec. 14, 1998, the contents of which have been incorporated by reference at page 27, lines 18-21 of the present application.

Claim 22 and 23 have been clarified to eliminate the rejection under 35 U.S.C. 112, second paragraph, raised in paragraph 7 of the Office Action. Support for this clarification can be found, e.g., at page 25, lines 15-20 of the present application. Claim 27 has also been clarified. Claim 41 introduced herein recites the positive step of ensuring not more than about 32% void volume in the thus-formed osteoimplant while Claim 42 finds support in Table 2 on page 36 of the specification and Claim 43 finds support at page 5, lines 16-22 of the specification. Claims 44-47 find support in the subject matter incorporated by reference herein. Additionally, Claim 48 recites the positive step of entangling the elongate bone particles while Claim 49 finds support, e.g., in the paragraph bridging pages 14-15 of the present application.

Accordingly, the present amendment to the claims finds clear, unequivocal support throughout the present application and drawings. Therefore, the only outstanding issue is the art rejection of the claims.

More particularly, Claims 14-32 have been rejected under 35 U.S.C. §102 as being anticipated by, or alternatively under 35 U.S.C. §103 as obvious over WO 99/39757 in paragraph 10 of the Office Action and also as being anticipated by or obvious over U.S. Pat. No. 5,507,813 to Dowd et al in paragraph 11 of the Office Action. However, it is respectfully submitted all claims presented herein are both novel and unobvious over these two references, for the following reasons.

A copy of the International Preliminary Examination Report issued in the counterpart PCT application is enclosed. All claims pending in the counterpart PCT application, including the method claims, were found to possess novelty and inventive step (unobviousness) over these two references. More particularly, it is recognized the applied art fails to explicitly disclose an osteogenic osteoimplant possessing an average void volume not greater than about 32%. It is then recognized Comparative Example 1 of the present application (pages 33-35) shows the osteoimplant of Dowd et al has 37.2% empty space (void volume) while the implant of Example 2 possesses 26% empty space (void volume).

Furthermore, it is recognized in the International Preliminary Examination Report that page 40, Table 5 in the present application provides conclusive evidence of improved physical properties in the osteoimplant prepared according to the present invention, thus providing technical advantage compared to osteoimplants prepared according to the prior art. For example, it is noted in the


International Preliminary Examination Report an implant prepared according to Dowd et al at least partially returned to its original bent configuration than an implant prepared according to the present application. The implants prepared according to the present invention, for the most part, exhibited no such tendency or "memory"; a flexible membrane which exhibits little if any memory will tend to remain conformed to the shape of the site where implanted.

Thus not only do WO 99/39757 and Dowd et al fail to anticipate the claimed invention, but the claimed invention provides distinct advantages over these references, therefore not being rendered obvious by these references. The remaining art of record has not been applied against the claims and will not be commented upon further at this time.

Accordingly, in view of the forgoing amendment and accompanying remarks, it is respectfully submitted all claims pending herein are in condition for allowance. Please contact the undersigned attorney should there be any questions. A petition for an automatic three month extension of time for response under 37 C.F.R. §1.136(a) is enclosed in triplicate together with the requisite petition fee and fee for additional claims introduced herein.

Early favorable action is earnestly solicited.

Respectfully submitted,


George M. Kaplan
Reg. No. 28,375
Attorney for Applicants

DILWORTH & BARRESE, LLP
333 Earle Ovington Blvd.
Uniondale, New York 11553
(516) 228-8484